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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,486	11/27/2001	Shinichi Watanabe	P20705	8162
7055	7590	07/12/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KOROBV, VITALI A	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/993,486	WATANABE ET AL.	
	Examiner	Art Unit	
	Vitali Korobov	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/29/05, 01/11/06</u> | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

1. This Office Action is in response to the amendment filed on 04/17/2006.

Claims 12-18 were amended. Claims 12-18 are pending in this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim, 12, 16 and 17 recite "... an IP address related to the receiving IP address".

The nature of this relationship is a new matter that has not been described in the specification. In view of absence of a specific description of this relationship, the Examiner broadly interpreted it as any relationship that may exist between receiving IP addresses of parts of a system.

All dependent claims are rejected as having the same deficiencies as the claims they depend from.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by the U. S. Patent 6,944,273 to Huna, hereinafter Huna.

Regarding claim 12, Huna teaches a server apparatus (Fig. 4, the message server 402) connected to a transmitting IP apparatus, the transmitting IP apparatus (Fig. 5, IP apparatus 504) transmitting an e-mail (Fig. 5, box 506) to a receiving IP apparatus (Fig. 5, fax 524, PC 532, etc.) via the server apparatus (Fig. 4, servers 402 and 404), the server apparatus comprising: a memory configured to store an IP address related to the receiving IP apparatus in association with a telephone number related to the receiving IP apparatus (Col. 15, lines 19-25 and lines 51-55), the IP address related to the receiving IP apparatus being distinct from an e-mail address (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address); a receiver configured to receive the e-mail from the transmitting IP apparatus (Col. 16, lines 30-35. User 502 sends message 508 in e-mail format, and IP apparatuses of Joe, Jim and Julie receive it), the e-mail including the telephone number related to the

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receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number); an analyzer configured to obtain, from the received e-mail, the telephone number related to the receiving IP apparatus, and to obtain, from the memory, the IP address of the receiving IP apparatus associated with the telephone number related to the receiving IP apparatus, the receiving IP apparatus to which the IP address is related, being the same as the receiving IP apparatus to which the telephone number is related (Col. 15, lines 50- 60); and a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address related to the receiving IP apparatus (Col. 15, lines 50- 60).

Regarding claim 15, Huna teaches the server apparatus according to claim 12, wherein a header of the e-mail from the transmitting IP apparatus includes the telephone number related to the receiving IP apparatus (Fig. 7, "To:" field, indicating Richard's telephone number, which is distinct from Richard's IP Address).

Claim 16 is rejected in view of the above rejection of claim 12. Claim 16 is essentially the same as claim 12, except that it sets forth the invention as a system rather than a server apparatus, as does claim 12.

Claim 17 is rejected in view of the above rejection of claim 12. Claim 17 is essentially the same as claim 12, except that it sets forth the invention as a method rather than a server apparatus, as does claim 12.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 13, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huna in view of the U.S. Patent 6,748,057 to Ranalli et al., hereinafter Ranalli.

Regarding claim 13, Huna teaches the server apparatus according to claim 12.

Huna does not explicitly teach the server apparatus wherein the transmitter transmits an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus.

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However, Ranalli in analogous art, related to directory service for enabling communications over a data network such as the Internet, and more particularly to the use of a unique identifier (for example, a telephone number) with this directory as a means for acquiring the associated data network address information for an intended recipient of a communication, teaches industry standard mail transmission protocol, and transmission of an error message to the transmitting IP apparatus when the memory does not store the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus. (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation. The industry standard implementation of SMTP (according to RFC 821, August 13, 1982) provides for error notification if the recipient is not registered (Reply Code 550)).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to incorporate the teachings of Ranalli regarding implementation of industry standard SMTP protocol for e-mail transmission to simplify transfer of electronic mail and to implement many other convenient features SMTP provides.

Regarding claim 18, Huna/Ranalli combination teaches the server apparatus according to claim 12, wherein the transmitter transmits the received e-mail to the receiving IP apparatus, based on the IP address related to the receiving IP apparatus, in association with a SMTP protocol (See Ranalli, col. 5, lines 9-12, where Ranalli teaches the use of SMTP protocol as one possible mode of implementation, and

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col. 5, lines 50-55, where Ranalli teaches conversion of an e-mail address in a telephone number format into the IP address of the receiving IP apparatus).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huna in view of the U.S. Patent 6,735,617 to Goodman (hereinafter Goodman).

Regarding claim 14, Huna teaches the server apparatus according to claim 12, but fails to explicitly teach such server being connected to a H.323 gatekeeper, being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus, the analyzer being configured to determine whether the memory stores the IP address related to the receiving IP apparatus, and when it is determined that the memory does not store the IP address related to the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address related to the receiving IP apparatus.

However, Goodman in analogous art, related to transmission of e-mail, i.e. facsimile copies of documents over H.323 network, teaches a server that is being connected to a H.323 gatekeeper, the H.323 gatekeeper storing the IP address of the receiving IP apparatus in association with the telephone number of the receiving IP apparatus (Goodman, Fig. 10, sender's mail server 950, and the outbound H.323 gateway 965. See also col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), the analyzer being configured to determine whether the memory

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stores the IP address related to the receiving IP apparatus (See col. 4, lines 6-7, where Goodman teaches an H.323 gatekeeper's function of finding an IP address for a gateway associated with a telephone number), and when it is determined that the memory does not store the IP address related to the receiving IP apparatus, the transmitter accesses the H.323 gatekeeper to obtain the IP address related to the receiving IP apparatus (See col. 4, lines 65-67, where Goodman teaches that the "IP address – telephone number" look-up table may be maintained at the facsimile mail server or at the H.323 Gatekeeper).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the alternative locations for a look-up table taught by Goodman with the teachings of Huna in order to take advantage of special records designating which IP addresses are mail servers and make cross-service connectivity in telecommunications network even more seamless and efficient (See col. 3, lines 62-67 and col. 4, lines 1-8 of Goodman).

7. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Response to Arguments

8. Applicant's arguments filed on 04/17/2006 have been fully considered but

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they are not persuasive.

With respect to the rejection of claims 12 and 15-17, the Applicants argue – ***“HUNA does not disclose at least a server apparatus that obtains, from the received e-mail, the telephone number related to the receiving IP apparatus, and obtains, from the memory, the IP address related to the receiving IP apparatus associated with the telephone number related to the receiving IP apparatus, the receiving IP apparatus to which the IP address is related being the same as the receiving IP apparatus to which the telephone number is related. Rather, HUNA obtains an IP address of the local POP 408 (516), corresponding to the embedded telephone number of the receiving device (520, 524, 528 and 532) (col.15, lines 52-60 and col.16, lines 53-58). As shown in Figs. 4 and 5, in HUNE, the local POP 408 (516) to which the IP address is related clearly distinct from the receiving device (520, 524, 528 and 532) to which the telephone number is related.”***

The Examiner respectfully submits that Huna does teach the server that the Applicants describe. It is a message server 402. The server 402 comprises an analyzer that is intelligent enough to take a message in text format, e-mail being one example, determine that it is going to a recipient having a voice-only receiving device, and use the translation logic and special-purpose software to translate the message text-to-voice (Col. 15, lines 31-51). The message is then sent "directly to the IP address of a recipient" as stated word-for-word in line 54 of col.15 of Huna. The Applicants chose to

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disregard this passage cited in the Office Action, and instead chose to focus on a special case of recipients, who are connected to telephony-centric network, in which case the message is sent to the IP address of the local POP. The local POP is related to the recipient's telephone number by being connected to it, and having the same IP address, since recipients on a telephony-centric network cannot have any IP addresses other than the IP address of their local POP, because a telephony-centric network is different from digital telephony network, where each telephone does have its own IP address, and in which case the message is routed "directly to the IP address of a recipient" as stated in line 54 of col.15 of Huna.

The Applicants further argue – ***“Further, HUNA does not disclose at least a server apparatus that includes a transmitter configured to transmit the received e-mail to the receiving IP apparatus, based on the IP address related to the receiving IP apparatus. Rather, in HUNA, the message server 402 (514) routes the message to the IP address of the local POP 408 (516) corresponding to the embedded telephone number of the receiving device (520, 524, 528 or 532) (col.15, lines 52-60 and col.16, lines 53-58). The local POP 408 (516) directs the local switch 454 (516) to call the receiving device over the telephony-centric network (col.15, lines 60-65) using the embedded telephone number of the receiving device (col.17, lines 43-63).”***

The Examiner respectfully refers the Applicants to col. 15, lines 52-54 of Huna, which state: "The message server 402 routes messages designated for receiving

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devices connected to the data-centric network 406 directly to the IP address of a recipient." The Applicants' arguments regarding POP 408 have already been addressed.

Regarding the rejection of the remaining claims 13, 14, and 18, where the Applicants argue against the references individually, and claim they lack a feature that a particular reference has not been cited for, the Examiner respectfully points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Therefore, the Office respectfully maintains the rejection of claims 12-18.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAK
07/04/2006

Vitali Korobov
Examiner
Art Unit 2155


BHARAT BAROT
PRIMARY EXAMINER